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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,171	08/09/2000	Emanuel Israel Cooper	13521(ARC9-2000-0067-US1)	5758

7590

03/25/2002

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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 03/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-8

Office Action Summary	Application N .	Applicant(s)	
	09/634,171	COOPER ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 to 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Rawlings et al. (Rawlings, US Patent No. 4,933,026, cited in the IDS submitted by applicants on October 24, 2000) and Kakuno et al. (Kakuno, cited in the IDS submitted by the applicants on October 24, 2000).

Each of these references teaches specific examples alloys having compositions that are encompassed by the alloy composition recited in the instant claims (see Rawlings, columns 1 and 2, Table 1, Alloys 4 and 10; and Kakuno, pages 3223, Figures 2 and 3 and Table 1, Alloys 7 to 9). Further, the specific alloys taught by Rawlings have

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saturation magnetization values of 2.45 and 2.44 Tesla which are encompassed by the saturation magnetization values recited instant claims 1 to 10.

The claims and the references differ in that the references do not teach all the alloy properties recited in instant claims 1 to 10.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloys taught by the references have compositions that are encompassed by the instant claims and therefore the alloys taught by the reference would be expected to possess all the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).” (emphasis added by the Examiner) see MPEP2112.01.

Response to Arguments

4. Applicant's arguments filed January 15, 2002 have been fully considered but they are not persuasive.
5. Applicants' argue that the instant claims are directed to a film and therefore distinguish over Rawlings' alloy which has a thickness of 2.5 mm. This is not

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persuasive. Applicants have not pointed to any disclosure in Rawlings which limits Rawlings' alloy to a thickness 2.5 mm. It appears that applicants may be relying on column 1, line 54 of Rawlings. However, Rawlings teaches that the alloy is worked to a thickness of 0.35 mm (column 1, line 51). The use of the term, "film" in the instant claims does not distinguish the claimed alloy from Rawlings alloy strip having a thickness of 0.35 mm nor does the term "film" distinguish the claimed alloy from Rawlings' alloy having a thickness of 2.5 mm.

6. Applicants' argue that Rawlings' alloy is too thick to be employed in the use to which the instantly claimed alloy film is intended, as a magnetic thin film head, and that this establishes the unobviousness of the instantly claimed invention. The Examiner is not persuaded. As set forth above the use of the term, "film" in the instant claims does not distinguish over the alloys taught by Rawlings. Further, the instant claims are silent with respect to the intended use of the claimed alloy. However, even if the claims did recite an intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

7. Applicants' arguments regarding processing requirements are not persuasive. Applicants' claims are directed to an alloy and not to a process. Any differences that

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may exist in the process of making the claimed alloy versus Rawlings' method of making the alloy do not lend patentability to the claimed alloy.

8. Applicants' argument that the instant claims exclude the presence of other metals such as niobium and tantalum which are included in Rawlings' example alloys cited by the Examiner in making this rejection is not persuasive. The instant claims recite "comprising". The use of the open claim language, "comprising" (claim 1, line 1) "is inclusive or open-ended and does not exclude additional unrecited elements" MPEP 2111.03. Thus the instant claims encompass the niobium and tantalum taught by Rawlings.

9. Applicants' argument based on the allegation that additional alloying elements compromises the "saturation magnetic moment" (applicants' response, page 8) of the alloy is not persuasive in view of the fact that Rawlings teaches specific alloys having saturation magnetization values of 2.45 and 2.44 Tesla (column 1 and 2, Alloys 4 and 10) which are encompassed by the instantly claimed saturation magnetization values.

10. Regarding Kakuno, applicants argue that the alloys in Table 1 of Kakuno cited by the Examiner in making the rejection are not encompassed by claims 2 and 3. The Examiner is not persuaded. Although claims 2 and 3 may not encompass the alloys taught by Kakuno in Table 1, the alloys of claims 2 and 3 appear to be anticipated by Kakuno's Figures 2 and 3. Further, the alloys in Table 1 of Kakuno cited by the Examiner in making the rejection are encompassed by claims 1 and 4 to 10.

11. Applicants' arguments regarding Kakuno not teaching an alloy film as recited in the claims but rather teaching the alloy on a copper substrate are not persuasive. As

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drafted applicants' claims do not preclude the presence of a copper substrate, that is, the instant claims encompassed the claimed alloy film on a substrate as taught by Kakuno.

12. Applicants' argument that Kakuno does not provide any of physical properties recited in the instant claims is not persuasive. Applicants have not specifically pointed out the physical properties that they are referring to in their argument. Further, for the reasons set forth in the statement of the rejection one of ordinary skill in the art would have expected have expected the alloys taught by Kakuno to possess all the same properties as recited in the instant claims, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).” (emphasis added by the Examiner) see MPEP2112.01.

13. Applicants' argument that it is well established in the case law that a reference must be enabling and that Kakuno is not enabling with respect to the manufacture of film is not persuasive. Applicants, although referring to case law in general, have not cited any specific case law in support of their position. Further, as previously set forth

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above, as drafted the instant claims do not exclude the copper substrate taught by Kakuno.

Conclusion

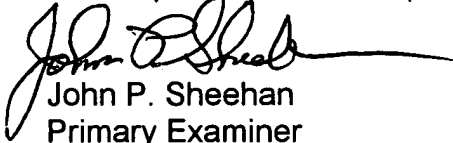
14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


John P. Sheehan
Primary Examiner
Art Unit 1742

jps
March 22, 2002